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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,206	01/02/2002	Vishwanath R. Lingappa	UCSF.002.01US	1150

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EXAMINER

WINKLER, ULRIKE

ART UNIT PAPER NUMBER

1648

DATE MAILED: 02/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,206

Applicant(s)

LINGAPPA ET AL.

Examiner

Ulrike Winkler, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to a method of isolating an HIV capsid intermediate, classified in class 530, subclass 412.
- II. Claims 7-9, drawn to a method of identifying a chaperone protein for HIV capsid assembly, classified in class 436, subclass 501.
- III. Claims 10 and 11, drawn to a method of identifying a conformer of a host cell protein involved in HIV capsid assembly, classified in class 430, subclass 344.
- IV. Claims 12-14, drawn to a method of producing a monoclonal antibody that recognizes a conformer involved in HIV capsid assembly, classified in class 530, subclass 388.1.
- V. Claims 15 and 19, drawn to a method of identifying the structure of the interaction site between the chaperone protein and the HIV capsid intermediate, classified in class 435, subclass 7.1.
- VI. Claims 16-18, 20 and 21, drawn to a method of identifying compounds that interfere with capsid assembly, classified in class 435, subclass 4.
- VII. Claims 22-23, drawn to a method of identifying conformers of the HIV assembly chaperones in an HIV infected individual, classified in class 424, subclass 9.2.
- VIII. Claims 24-28 and 40, drawn to an HIV capsid intermediate, classified in class 424, subclass 208.1.
- IX. Claims 29-34, drawn to a cell free system for producing an HIV capsid intermediate, classified in class 800, subclass 320.1.

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- X. Claims 35-39 and 50, drawn to a method of producing an HIV capsid intermediate using a cell free system, classified in class 436, subclass 543.
- XI. Claims 41-42 and 46-47, drawn to a method of selecting a compound capable of altering HIV assembly by using a cell free translation mixture, classified in class 424, subclass 9.2.
- XII. Claims 43-45, drawn to a host cell protein, classified in class 530, subclass 350.
- XIII. Claims 48-49, drawn to a method of selecting a compound that is capable of altering HIV assembly in a cell, classified in class 424, subclass 9.2.

The inventions are distinct, each from the other because of the following reasons:

Groups VIII, IX and XII are compositions and are distinct from Groups I-VII, X, XI and XIII which are drawn to methods. Groups VIII, IX and XII are compositions and each is distinct from the other because they contain different materials. Group VIII is drawn to a capsid intermediate. Group IX comprises a cell free system, which is made up of HIV mRNA and myristoyl CoA. Group XII to a host cell protein that is involved in capsid assembly. Though there may be overlap for these groups, the search for one group will not be coextensive with that of the other group.

Groups I-VII, X, XI and XIII are drawn to methods and each is distinct from the other because they utilize different starting materials, therefore the outcomes are not be expected to be the same. Group I is a method of isolating a capsid intermediate, Group II is drawn to a method of identifying a compound that is involved in capsid assembly. Group III is drawn to a method that looks for conformers of compounds that are involved in capsid assembly, this method

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requires knowledge that such a compound exists before being able to identify conformers. Group IV is drawn to a method of producing antibodies that recognize conformers. Group V is drawn to method of identifying the structure that comprises the binding site between the capsid and the chaperone. Group VI is drawn o a method of identifying compounds that interfere with capsid assembly. Group VII looks at identifying conformers that are present in an HIV infected patient. Group IX is drawn to a method of producing a capsid intermediate. Group XI drawn to a method of identifying a compound that interfere with capsid assembly in a cell free system. Group XIII drawn to a method of identifying a compound that interferes with capsid assembly in a cell.

Inventions X, IX and VIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the cell free translation mixture can be used to make compositions that can function as antigens.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294. The examiner can normally be reached M-F, 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 703-308-4027.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 or for informal communications use 703-308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Ulrike Winkler, Ph.D. 2/3/05